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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,451	02/22/2005	Veli Kasma	METSO-21	1379
36528	7590	04/20/2005	EXAMINER	
STIENNON & STIENNON 612 W. MAIN ST., SUITE 201 P.O. BOX 1667 MADISON, WI 53701-1667			PARKER, FREDERICK JOHN	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/507,451

Applicant(s)

KASMA ET AL

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-13-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title is too generic.

### ***Claim Objections***

3. Claim 8 is objected to because of the following informalities: claim 8, "coated" should be inserted before "web" for clarity. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10,11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 10,11 are vague and indefinite because the relative term "hard" does not convey nor distinctly claim the intended hardness of the rolls.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-12,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tholome FR 1436020 in view of Williams Jr et al US 3549403.

Tholome teaches an electrostatic coating process for simultaneously coating both sides of a continuous paper substrate (web) (fig. 2). Electrostatic applicators of practically the same potential but of opposite sign are placed on opposing sides of the substrate so the charged particles delivered by one applicator of a given sign are attracted to the substrate surface by the opposite sign of particles applied by the other applicator of opposing sign on the opposite side, following the fundamental principle of electrostatic coating. (see last page of translation). The particles may be solids or liquids, without further limitation. Finishing the coated surfaces through a nip comprising heated members is not cited.

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Williams Jr teaches applying powder (preferably electrostatically) to a paper sheet, and then the coated sheets are subjected to hot compression rolling to form an adherent, bonded coating (col. 2, 11-35; col. 3, 6-22). Rolls containing heating means 34,36 form a nip between which the coated sheet passes for compression and fusion. The rollers are heated to temperatures exemplified (EX 1-14) by 300F/ 149C to 325F/163C which overlaps the range of claim 12. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the temperatures disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. The rollers necessarily possess a hardness greater than the paper to accomplish compression.

While roughness of the rolls of Williams Jr is not disclosed, per claim 11, it teaches the compressed coatings must be uniform so the rollers must be machined to a sufficient degree of smoothness to achieve such uniformity as determined by one of ordinary skill for a desired end-use application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Tholome by incorporating the heated compression rolls of Williams Jr et al to provide a uniform coating adherently bonded to the paper substrate.

9. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tholome FR 1436020 in view of Williams Jr et al US 3549403 alone, or further in view of Liberto.

Tholome and Williams Jr et al are cited for the same reasons previously discussed, which are incorporated herein. Use of corona discharge electrodes are not expressly taught. However, it is

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the Examiner's position that the electrical schematic of figure 2 of Tholome depicts corona discharge, the specific charge from the high voltage source applied to the electrodes forming charged ions which, in turn, charge the powder being propelled at the substrate to form an electrostatic powder coating. This principle is shown by Liberto which supports the Examiner's position. While Tholome shows pipe openings as electrode means, it is the Examiner's position that the skilled artisan would have known to substitute any functionally equivalent electrode means, such as the wire-shaped electrodes of claim 14, because of the expectation of charging the coating particles.

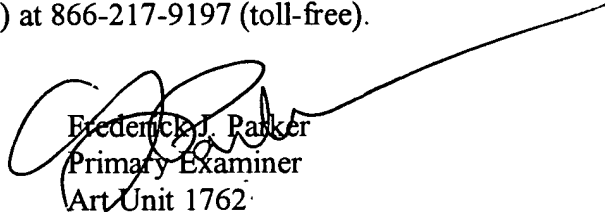
It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Tholome in view of Williams Jr et al using the corona electrodes inferred by Tholome, or alternatively further as described by Liberto, because of the expectation of electrostatically charging powder coating particles being applied to a substrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meeks Timothy can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp